

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

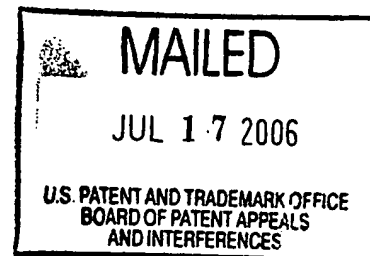
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DALE C. FLANDERS
and
PETER S. WHITNEY

Appeal No. 2005-0177
Application No. 09/645,827

ON BRIEF



Before WARREN, OWENS and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

Previously, this application came before us pursuant to Appellants' appeal of the Examiner's decision to finally reject claims 1-8 and 17-20 under 35 U.S.C. § 102(b) as being anticipated by an article authored by Wolfgang Andreasch et al (Wolfgang). Pursuant to that appeal, we affirmed the decision of the Examiner to reject the claims (Decision of February 15, 2005). Appellants appealed our Decision to the Court of Appeals for the Federal Circuit. The Court did not decide the issues on appeal, instead, pursuant to a joint motion by Appellants and the PTO, the Court remanded the case to the PTO for further proceedings (Order of Aug. 26, 2005). This application is now before us pursuant to that remand.

Since our previous Decision (Decision of February 15, 2005), our reviewing court, the Court of Appeals for the Federal Circuit, has provided new guidance on how claims are to be interpreted. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312, 75 USPQ2d 1321, 1325 (Fed. Cir. 2005)(*en banc*). As a result, a reevaluation of the scope and content of the claims in the present case is required. We vacate our previous Decision and remand the application to the Examiner for appropriate action consistent with the following discussion.

The Examiner should consider the meaning of the claim terms in light of the specification. The context of the specification is highly relevant to the meaning of claim terms. This contextual-based analysis does not just apply to claim construction within the courts but also applies to claim interpretation during examination. *See Phillips*, 415 F.3d at 1316, 75 USPQ2d at 1329 (*quoting In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364, 70 USPQ2d 1827, 1830 (Fed. Cir. 2004)(During examination, “claims ... are to be given their broadest reasonable interpretation consistent with the specification, and ... claim language should be read ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’”). The *en banc* court in *Phillips* made clear that “[i]t is the person of ordinary skill in the field of the invention through whose eyes the claims are construed.” *Phillips*, 415 F.3d at 1313, 75 USPQ2d at 1326. “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.*

Below we provide the Examiner some guidelines for performing claim interpretation.

Claim 1

Focusing first on claim 1, we note that this claim recites four structures as part of the production line apparatus: (1) an optical bench supply, (2) a component supply, (3) a pick-and-place machine, and (4) an optical system aligner. Most of the controversy on appeal has been directed to the last structure, the optical system aligner, and, in particular, on the language “which have been attached.” But to better understand the claim as a whole the Examiner should step back and consider how the claim language limits each of the claimed structures and the apparatus as a whole.

Turning to the fourth recited structure of the claim, i.e., optical system aligner, this limitation contains two functional clauses separated by the word “and.” The first functional clause is directed to characterizing the positions of the optical components, which have been attached to the optical benches. The second functional clause is directed to mechanically adjusting the relative positions of the optical components. Appellants’ arguments imply that “which have been attached” modifies the second clause, i.e., the mechanical adjustment clause, as well as the first clause, i.e., the characterization clause. The Examiner should determine, and discuss on the record, whether this is the case. The Examiner should make this determination considering that “which have been attached” is only recited in the first clause, the phrase is separated by commas, and the word “and” separates the clauses.

Previously, the Examiner had relied upon a dictionary definition to construe “attached.” The Examiner had consulted the specification, but determined that “because Appellants have not

defined the term 'attached' in the specification, it is the examiner's position that one of ordinary skill in the art would give a broader interpretation to the term and construe it to mean 'be in contact with' as defined by [T]he American Heritage Dictionary, Fourth Edition." (Answer, p. 6). Appellants responded that, upon Applicant's best information, the fourth edition of The American Heritage Dictionary does not contain the definition cited by the Examiner (Reply Brief, p. 1). Appellants reproduce a set of definitions said to be from the fourth edition of The American Heritage Dictionary (Reply Brief, p. 2).

The Examiner should reevaluate the meaning of "attached" by considering how one of ordinary skill in the art would interpret this term in light of the specification as it would be interpreted by one of ordinary skill in the art. The specification is created for the purpose of explaining the invention to one of ordinary skill in the art whereas extrinsic evidence, such as dictionary definitions, is not created for that express purpose and may not properly reflect the understanding of a skilled artisan in the particular field of the invention. *Phillips*, 415 F.3d at 1318, 75 USPQ2d at 1330-31. That is not to say dictionary definitions do not have their place in the claim interpretation equation, it is merely to say that the flaws inherent in each type of evidence must be kept in mind when weighing the evidence. "[W]here reference to dictionaries is appropriate, the task is to scrutinize the intrinsic evidence in order to determine the most appropriate definition." *Free Motion Fitness, Inc. v. Cybex Intern., Inc.* 423 F.3d 1343, 1348, 76 USPQ2d 1432, 1436 (Fed. Cir. 2005). If the Examiner relies upon evidence of a meaning within the art or any dictionary definition, documentation should be placed in the record.

Further with regard to the “optical system aligner” limitation, the Examiner must consider not only how the functional term “attached” should be interpreted, but also how the functional clauses as a whole limit the optical system aligner structure. Guidance in the specification such as that found at page 25, line 26 to page 26, line 6 should be considered. This portion of the specification recites the following:

In the preferred embodiment, the optical benches, with the alignment structures affixed thereto are then fed to an alignment system. This alignment system 2020 has the jaws 710A, 710B which grasp the handle of the alignment structure 100 to effect [sic] alignment. In the preferred embodiment, this alignment is active alignment in which the magnitude of the optical signal 2022 is detected by a detector 2024. The alignment structure 100 is manipulated and deformed until the optical signal 2022, detected by the detector 2024, is maximized. Alignment search strategies such as a hill-climbing approach or spiral scan approach are preferably utilized.

In other situations, such as when installing optical fibers on the bench 10, the alignment structure is preferably installed first without the fiber attached by the pick and place machine 2016. Then at the alignment system, the fiber is fed through a fiber feed through in the module and attached, such as by solder bonding, to the alignment structure 100. Then the alignment system manipulates the structure to effect [sic] alignment.

The question here is: What does claim 1 require in terms of structure with regard to the “optical system aligner”? Claim 1 requires that the optical system aligner characterize the positions of the optical components, which have been attached to optical benches, and mechanically adjust the relative positions of the optical components. The above reproduced passage discusses characterizing position by a detector 2024 that detects an optical signal 2022. The above reproduced passage also discusses jaws 710A and 710B that perform mechanical adjustment. The Examiner should determine the scope of the structures encompassed by the “optical system

aligner” in light of the specification taking care not to read extraneous limitations from the specification into the claim. *See Phillips*, 415 F.3d at 1323, 75 USPQ2d at 1334 (“[T]he line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms. For instance, although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments.”).

Once the Examiner determines the claim scope, the Examiner must compare the claimed invention with the prior art. With regard to Wolfgang, we note that section 5.3 on pages 166-67 discusses a two-step process in which a first optical element, for example a lens, is roughly positioned on a mounting plate and attached by welding and then a second optical component, for example a laser diode, is roughly positioned on the mounting plate and further positioned relative to the lens by shining a collimated beam through the lens. It can be argued that the first optical element (lens) is mechanically adjusted during the initial rough positioning and its position characterized during the detection of the collimated beam shining through the lens during the positioning of the second optical component (laser diode). This characterization of position occurs after the first optical component (lens) is welded to the mounting plate (bench) and, therefore, this characterization of the first optical component (lens) takes place after its attachment. If claim 1 is interpreted to allow mechanical adjustment before attachment, the

Examiner should consider whether section 5.3 of Wolfgang describes the optical system aligner of claim 1.

Claim Interpretation under 35 U.S.C. § 112, ¶ 6

Claim 17 brings up another claim interpretation issue. Particularly, claim 17 includes a means-plus-function clause. Such a clause raises the presumption that 35 U.S.C. § 112, ¶ 6 applies. The Examiner is required under § 112, ¶ 6 to look to the specification and construe the “means” language as limited to the corresponding structure disclosed in the specification and equivalents thereof. *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)(*en banc*). A structure disclosed in the specification qualifies as “corresponding” structure only if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim. *See Medtronic, Inc. v. Advanced Cardiovascular Systems, Inc.*, 248 F.3d 1303, 1311, 58 USPQ.2d 1607, 1614 (Fed. Cir. 2001).

The Answer does not identify the “corresponding” structures associated with the function in claim 17. The Examiner must clearly identify, on the record, what structures recited in the specification correspond to the means when and if claims containing means-plus-function limitations are rejected over prior art. Where the identity of the corresponding structure would be unclear to one of ordinary skill in the art reading the specification, the affected claims should be rejected under 35 U.S.C. § 112, ¶ 2. *See Donaldson*, 16 F.3d at 1195, 29 USPQ2d at 1850 (“[I]f one employs means-plus-function language in a claim, one must set forth in the specification an

adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.”).

Once the corresponding structure is identified, the Examiner should determine whether the structures in the prior art are the same as the corresponding structures disclosed in the specification for performing the function. Only if they are not, the Examiner proceeds to determine whether the prior art structures are “equivalents” within the meaning of 35 U.S.C. § 112, ¶ 6.

In the Answer at pages 7-11, the Examiner sets forth an “equivalents” analysis using a test recited in *Kemco Sales, Inc. v. Control Papers Co., Inc.*, 208 F.3d 1352, 1364, 54 USPQ2d 1308, 1315 (Fed. Cir. 2000). According to *Kemco*, “a section 112, paragraph 6 'equivalent[]' . . . [must] (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure.” *Id.* at 1364, at 1315. Further, “two structures may be 'equivalent' for purposes of section 112, paragraph 6 if they perform the identical function in substantially the same way, with substantially the same result.” *Id.*

The means-plus-function limitation in claim 17 is: “means for characterizing the positions of the optical components attached to the optical benches, and for mechanically adjusting the relative positions of the optical components attached to the benches.” With respect to the first functional clause, the examiner argues “that merely because Appellants’ system operates after the bonding step while Wolfgang et al. system operates prior to bonding step does not overcome the

substantial similarities of the two systems function, namely using a laser and corresponding laser detector to determine when an optical component is aligned on an optical bench (compare Appellants' specification, page 26, first paragraph and see generally Appellants' specification, page 19, fourth paragraph to Wolfgang et al, section 5.2, ll. 3-5 and section 5.3, second full paragraph)" (Answer, pp. 8-9). With respect to the second functional clause directed to mechanical adjustment, the Examiner states the function as "arranging a component onto an optical bench." (Answer, p. 9). The function required by claim 17 is not "using a laser and corresponding laser detector to determine when an optical component is aligned on an optical bench" nor is it "arranging a component onto an optical bench." The required function is "characterizing the positions of the optical components attached to the optical benches, and mechanically adjusting the relative positions of the optical components attached to the benches." To establish a prima facie case of anticipation based on an "equivalent," the examiner must point out where Wolfgang discloses structure which performs that function, i.e., characterizing the positions of the optical components attached to the optical benches, and mechanically adjusting the relative positions of optical components after they have been attached to benches.

CONCLUSION

In summary, the instant application is remanded to the examiner, via the Office of the Director of the applicable Technology Center, to consider the aforementioned issues and to act accordingly.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

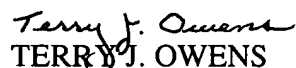
An appeal conference as mandated by *MPEP* § 1207.01 (8th ed., rev. 4, Oct., 2005) must be held before this case is subject to further appeal proceedings.

This application, by virtue of its "special" status requires an immediate action. *MPEP* § 708.01(D) (8th ed., Rev. 4, Oct. 2005). Both the Board and the Office of the Solicitor must be informed promptly of any action in this case (e.g., abandonment, issue, reopening prosecution).

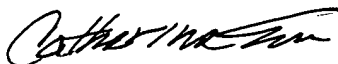
REMANDED



CHARLES F. WARREN
Administrative Patent Judge



TERRY J. OWENS
Administrative Patent Judge



CATHERINE TIMM
Administrative Patent Judge

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Appeal No. 2005-0177
Application No. 09/645,827

Page 12

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